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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/603,124 | 06/23/2000 | Markus Pompejus | BGI-132CP | 1469 |

959 7590 10/22/2002

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

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| EXAMINER |
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ZARA, JANE J

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1635

DATE MAILED: 10/22/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.

09/603,124

Applicant(s)

Pompejus et al

Examiner

Jane Zara

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 3, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-42, 47-52, and 55 is/are allowed.
- 6) ☒ Claim(s) 43-46, 53, and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

File

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DETAILED ACTION

This Office action is in response to the communication filed September 13, 2002, Paper No. 15.

Claims 39-55 are pending in the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments and Amendments

Withdrawn Rejections

Rejection of claims 1-17 and 35-38 under 35 U.S.C. 112, second paragraph, is withdrawn in light of Applicants' amendments, filed September 3, 2002, Paper No. 15.

Rejection of claims 1-17 and 35-38 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, is withdrawn in light of Applicants' amendments, filed September 3, 2002, Paper No. 15.

Rejection of claims 1-17 and 35-38 under 35 U.S.C. 112, first paragraph, for lacking enablement over the scope claimed, is withdrawn in light of Applicants' amendments, filed September 3, 2002, Paper No. 15.

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Rejection of claims 1, 3, 6-8, 10 and 12-14 under 35 U.S.C. 102(b) as being anticipated by either Kobayashi, Smith et al or Wachi is withdrawn in light of Applicants' amendments, filed September 3, 2002, Paper No. 15.

Maintained Rejections

Claims 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the Office action mailed February 26, 2002, Paper No. 13, as applied to claims 1-17 and 35-38.

Applicant's arguments filed September 3, 2002 have been fully considered but they are not persuasive. Applicants argue that adequate written description has been provided in the instant specification for the claimed invention, drawn to nucleic acid molecules at least 90% identical to SEQ ID NO: 1. Applicants further contend that written description has been provided for this scope because a functional limitation has been provided (i.e. capable of modulating the production of a fine chemical or capable of modulating cell wall biosynthesis. Contrary to Applicants' assertions, the inclusion of proposed functions for a polynucleotide sequence does not provide adequate written description for polynucleotides comprising 90% identity to SEQ ID NO: 1. No adequate number of representative species of the broad genus has been provided and furthermore no functions have been demonstrated for the claimed polynucleotide sequence of SEQ ID NO: 1, nor its claimed homologues.

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Claims 43-46, 53 and 54 are rejected under 35 U.S.C. 112, first paragraph, for lacking enablement over the scope claimed, for the reasons of record set forth in the Office action mailed February 26, 2002, Paper No. 13, as applied to claims 1-17 and 35-38.

Applicant's arguments filed September 3, 2002 have been fully considered but they are not persuasive. Applicants argue that one of ordinary skill in the art would be able to make and use the invention claimed without undue experimentation. Contrary to Applicants' assertions, no biochemical activity has been demonstrated for the polynucleotide of SEQ ID NO: 1, encoding the polypeptide of SEQ ID NO: 2, whereby a the modulation of production of any and/or all fine chemicals is obtained in the transfected cell, or whereby a modulation in cell wall biosynthesis is obtained in the transfected cell. It would require undue experimentation beyond that which has been provided in the instant application to determine the modulatory effects in the production of any and/or all fine chemicals, or to determine the modulatory effects in cell wall biosynthesis, upon transfection of an appropriate host cell with the claimed polynucleotide.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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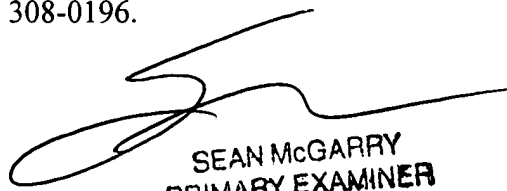
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is (703) 306-5820. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JZ

October 17, 2002


SEAN MCGARRY
PRIMARY EXAMINER
1635